

### **REMARKS**

Claims 1-23 are pending. Of these, claims 1, 2, 8, 9, 14 and 15 are written in independent format.

By this reply, claims 21-23 have been canceled and their subject matter incorporated into claims 1, 8 and 14, respectively.

Applicant is pleased to acknowledge, again, that claims 2-3, 9 and 15-16 are allowed.

### **§ 103 REJECTION**

Beginning on page 2 of the Office Action, the Examiner has rejected claims 1, 4-8, 10-14 and 17-23 under 35 U.S.C. §103 as being unpatentable over Applicant's Admitted Prior Art ("APA")<sup>1</sup> in view of "Dynamically Tunable Kernel Parameters in HP-UX 11i," an HP-UX 11i white paper from Hewlett-Packard (cited in IDS dated 5/6/2005, hereinafter, "the White Paper"). This rejection is traversed.

For simplicity, this traversal assumes the context of, e.g., claim 1, unless noted otherwise.

The Examiner acknowledges (see page 3 of Office Action) that the APA does not disclose the claimed step of "automatically determining whether application of the changes would violate a set of constraints." The Examiner believes that this is taught by the White Paper. As to the subject matter of now-canceled claim 21 that has been incorporated into amended claim 1, the Examiner states (on page 8 of the Office Action):

[The APA teaches that A]dministrators must be careful to change the (tuneable parameters) in the proper order to avoid violating the constraints paragraph [0003][]. The White Paper teaches that changes would automatically done using automatic tunables (top of page 4). It would have been obvious to one of ordinary skill in the art, having the teachings of AAPA and the White Paper before them at the time of the invention to automatically evaluate the order by which the proposed changes are effectuated in order to prevent violating constraints.

Though unstated, it seems to Applicant as if the Examiner's position is again<sup>2</sup> informed by *In re Venner*, 120 USPQ 193, 194 (CCPA 1958). Again, Applicant traverses.

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<sup>1</sup> Applicants admit that the APA does not represent a point of novelty for the present application and will assume for the sake of argument that it is available under some section of 35 U.S.C. §102. But Applicants do not admit that the APA necessarily is §102(b)-type art.

<sup>2</sup> In an interview with one of Applicant's representatives conducted on September 28, 2005, the Examiner reacted to some proposed claim amendments as having been obvious, characterizing them as mere automation of the previously manual process of the APA. Undoubtedly, the Examiner's assertion was informed by MPEP § 2144.04.III ("Automating A Manual Activity"), which cites *In re Venner*, 120 USPQ 193, 194 (CCPA 1958).

Among some Examiners, the Venner case has come to stand for the proposition that broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result is obvious. A more detailed discussion of the Venner case is provided below.

In the Venner case, Venner argued that a human operator of the prior art molding apparatus guessed the time at which the core section should be withdrawn, and then initiated the withdrawal of the core section leading to inconsistent quality of the resulting molded article. As such, Venner argued that his claimed combination of elements would not have been obvious.

Venner conceded, however, that the molding apparatus without the timing device and the associated means to initiate withdrawal of a core section of the molding apparatus (in response to the timing device) was not patentable over the prior art. The prior art disclosed suitable timing devices, and suitable devices to initiate withdrawal of a core section. Moreover, there was knowledge in the prior art as to the small interval of time in which it was optimal to withdraw the core section.

The CCPA viewed Venner's claims as amounting to no more than merely adding the word "automatically" to a description of some of the steps in the prior art molding process. On that basis, and given how close the prior art was to Venner's claims, the CCPA held that the Venner's claims were unpatentable.

Returning to the present application, the APA describes a manual process conducted by a system administrator. In particular, as noted by the Examiner, Paragraph (PGH) 3 of Applicant's specification states:

[0003] Many tunable parameters are related to each other by constraints. ... Administrators who wish to change related values must be careful to change the tunables in the proper order to avoid violating such constraints. This need for extra care makes tuning the system more difficult.

The above-quoted PGH 3 implies that a determination is made of a proper order for making changes to the tunables. But how does an Administrator know what the proper order is? Is a determination of the proper order made with each occasion at which changes to tunables are made? How is the proper order determined? The APA is silent as to details regarding proper order determination.

Amended claim 21 recites more than automatically determining whether application of the changes would violate a set of constraints. In particular, a distinction over the APA (and over the White Paper, for that matter) of amended claim 1 is that such determination includes automatically evaluating one or more alternate orders by which the proposed changes can be effectuated to identify whether a valid order exists that would not violate the set of constraints. As noted above, the APA implies only that a determination is made as to a proper order for making changes to the tunables. Beyond that, the APA is silent as to how such a determination was made. What evidence does the Examiner have that the APA's

determination was based upon automatically evaluating one or more alternate orders by which the proposed changes can be effectuated to identify whether a valid order exists that would not violate the set of constraints?

As noted previously,<sup>3</sup> it is questionable whether the Venner case remains good law. Even a mere nine years after the Venner case was decided, the court in the Decca case<sup>4</sup> chose not to rely on the Venner case for its holding touted in MPEP § 2144.04.III. despite it being asserted by the Defendant as grounds for invalidity. There, the Decca court distinguished the operation of the claimed phase discriminator and phase regulator as being substantially different than the activity of the operator who manually carries out the prior art process.

Here, Applicant submits that the machine-implemented method of claim 1 is patentable over the APA in the analogous way that the claims in the Decca case were held patentable. More specifically, the method of present claim 1, by which (among other things) a proposed set of changes is received and by which it is automatically determined whether application of the changes would violate a set of constraints including automatically evaluating one or more alternate orders by which the proposed changes can be effectuated to identify whether a valid order exists that would not violate the set of constraints, defines patentably distinct activity relative to what as done manually by the system administrator in the APA. Applicant has not merely presented claims that add the word “automatically” to a description of some of the steps in the APA.

Amended independent claims 8 and 14 recite features similar to those of claim 1 noted above and thus at least similarly distinguish over the combination of the APA and the White Paper. Claims 4-7, 10-13 and 17-20 depend from claims 1, 8 and 14, respectively, and at least similarly distinguish over the combination of the APA and the White Paper.

In view of the foregoing discussion, the §103(a) rejection is improper Applicants request that it be withdrawn.

### **CONCLUSION**

The issues raised in the Office Action are considered to be resolved. Accordingly, Applicant again requests a Notice of Allowance.

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<sup>3</sup> See Applicant's response filed January 11, 2006, beginning on page 11.

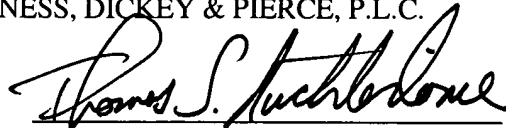
<sup>4</sup> *Decca v. United States*, 160 PQ 739, 750 (US ClCt 1969).

If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to contact the undersigned.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge any underpayment or non-payment of any fees required under 37 C.F.R. §§ 1.16 or 1.17, or credit any overpayment of such fees, to Deposit Account No. 08-2025, including, in particular, extension of time fees.

Respectfully submitted,  
HARNES, DICKY & PIERCE, P.L.C.

By:



Thomas S. Auchterlonie, Reg. No. 37,275  
P.O. Box 8910  
Reston, VA 20195  
(703) 668-8000

TSA/cm:tsa